

plainly definite, as are claims 2 to 9. Accordingly, it is respectfully requested that the indefiniteness rejections of claims 1 to 9 be withdrawn.

With respect to paragraphs five (5) and six (6), claims 1, 2, 5, 7 and 10 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,485,370 to Moss et al. (the “Moss reference”).

It is respectfully submitted that any review of the Moss reference makes plain that it simply does not in any way identically disclose or suggest an apparatus that includes a “*control and operating device executing a user interface to control and operate the service*”, in which the “*control and operating device is assigned to the user-side terminal*” and in which “*at least one network server transmits the user interface program to the control and operating device before the service is used*”, as in claim 1. Thus, claim 1 requires that the control and operating device is assigned to the user-side terminal and that the at least one network server transmits the user interface program to the control and operating device *before the service is used*.

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim limitation is identically disclosed in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). It is respectfully submitted that the Moss reference simply does not and cannot identically disclose (or even suggest) the foregoing features of claim 1, and this is evidenced by the fact that the Office Action does not in any way identify the foregoing features in the Moss reference.

The Moss reference purportedly concerns a system providing communication between a home terminal such as a telephone, and a service provider such as a financial institution. (See Moss, Abstract). Apparently, the system’s application software transforms user commands into commands understood by the service provider’s system, and a network host computer of the system provides messages to the home terminal to obtain required information from the user and then communicates this information to the service provider. (See id.).

Moreover, the Moss reference (at col. 3, lines 48 to 53) states that “updated versions of the application programs can be downloaded to the microcomputer automatically each time the consumer connects to the network, thereby ensuring that out-of-date application programs

are not used.” That is, the consumer’s terminal stores the programs downloaded from the service and the programs are updated when the user initiates service. The Moss reference (at col. 12, lines 45 to 61) also states that “[i]n establishing a communication session, the home terminal sends a connect request message” and then when the “session controller returns a connect response”, the “session is established and all subsequent communications proceed using the message format”, and that at the “beginning of each session, a series of messages are exchanged to determine if the application pages in the home terminal are replaced by current versions.” The Moss reference (at col. 18, lines 21 to 41) further states that a “telephone-computer accesses a network host”, the network host computer “provide[s] a series of application program pages which are downloaded to the terminal”, and the “downloaded program pages supply the terminal with sufficient ‘prompts’ to elicit from the user whatever information is required to access one of a plurality of service computers.” In short, the Moss reference purportedly concerns having the user do certain activities to update the programs stored on the user’s computer.

It is therefore respectfully submitted that the reference relied upon cannot and does not anticipate claim 1 since it does not identically disclose the claim 1 features discussed above, and that claim 1 is therefore allowable.

Since claims 2, 5 and 7 depend from claim 1, these claims are allowable for the same reasons as claim 1.

As regards claim 10, it includes features analogous to those of claim 1 -- including the “before the service is used” feature -- and is therefore allowable for essentially the same reasons as claim 1.

With respect to paragraph nine (9), claims 3, 4, 6, 8, 9, 11 and 12 were rejected under 35 U.S.C. §103(a) unpatentable over the Moss reference in view of U.S. Patent No. 5,838,682 to Dekelbaum et al. (the “Dekelbaum reference”).

As discussed above, the primary Moss reference does not in any way disclose or suggest the features of claim 1.

The secondary Dekelbaum reference purportedly concerns an internet type access system that includes an autodialer for automatically establishing communications with a merchant’s facility over a switch network while maintaining internet connectivity over a packet data network. As characterized, the autodialer coordinates between the internet

session and the switched connection with the merchant's server. (See Dekelbaum Abstract). Since any review of the Dekelbaum reference makes plain that it simply does not cure the critical deficiencies of Moss, it is respectfully submitted that claim 1 is allowable over the references as applied.

Since claims 3, 4, 6, 8 and 9 depend from claim 1, they are allowable for the same reasons as claim 1.

As discussed, claim 10 includes features analogous to those of claim 1, and is therefore allowable for essentially the same reasons as claim 1, as are its dependent claims 11 and 12.

Moreover, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the "problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem." (See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998)). It is respectfully submitted that, as discussed above, the references relied on, whether taken alone or combined, do not in any way suggest modifying or combining the references so as to provide the presently claimed subject matter for addressing the problem of improving user-access network-based services without requiring a terminal that is specifically adjusted to the service or program. (See Specification).

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that a subjective "obvious to try" standard is not proper. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original). In short, there must be evidence of why a person having ordinary skill in the art would be motivated to modify a reference to provide the claimed subject matter of the claims.

Accordingly, it is respectfully requested that the obviousness rejections of claims 3, 4, 6, 8, 9, 11 and 12 should be withdrawn for the foregoing reasons.

Finally, claims 1 and 8 were amended without prejudice to satisfy the antecedent basis requirements. These amendments do not add new matter, and it is respectfully requested that they be entered.

CONCLUSION

In view of all the above, it is believed that rejections of claims 1 to 12 have been obviated, and that currently pending claims 1 to 20 are allowable. It is therefore respectfully requested that the rejections be reconsidered and withdrawn, and that the present application issue as early as possible.

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AMENDMENT VERSION WITH MARKINGS

IN THE CLAIMS:

Claims 13 to 20 have been added without prejudice as indicated above, and claims 1 and 8 have been amended without prejudice as follows:

1. (Twice Amended) An apparatus for using a service made available in a telecommunications network, the [device] apparatus comprising:
 - at least one network server having a user interface program;
 - a user-side terminal, the user-side terminal being capable of connection to the at least one network server; and
 - a control and operating device executing a user interface to control and operate the service;

wherein the control and operating device is assigned to the user-side terminal and the at least one network server transmits the user interface program to the control and operating device before the service is used.
8. (Twice Amended) The apparatus as recited in claim 1 wherein the control and operating device [means] includes a JAVA execution-time environment.